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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,039	04/18/2001	William Whitehead	85939.000189	9206
23387	7590	11/18/2003	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			STRIMBU, GREGORY J	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,039

Applicant(s)

WHITEHEAD, WILLIAM

Examiner

Gregory J. Strimbu

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-9, 13-17, 20-23 and 42-76 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10/17/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 17, 2002 have been approved.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9, 55, 56, 57, 63 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Publication No. 197 44 240. German Patent Publication No. 197 44 240 discloses a vehicular weather seal 73 comprising an elongate polymeric body (not numbered, but seen in figure 8) including a sealing portion (not numbered), the sealing portion and the elongate polymeric body being monolithic, a seating channel (not numbered) extending along a longitudinal dimension of the polymeric body and a light generating line 58 connected to the body and extending along a longitudinal dimension of the body for generating and emitting light.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 13-17, 20-23, 42-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Oord in view of German Patent Publication No. 197 44 240 and German Patent Application No. 198 41 180. Van Den Oord discloses a vehicular weather seal which seals a gap intermediate a first confronting surface (not shown) and a second confronting surface (not shown), the first and second confronting surfaces moveable between a spaced apart open position and an adjacent closed position, the vehicular weather seal comprising an elongate polymeric body 6 attached to the first confronting surface, the polymeric body including a sealing portion 8, the sealing portion spaced from the second confronting surface in the spaced apart open position of the confronting surfaces and the sealing portion contacts the second confronting surface in the adjacent closed position of the confronting surfaces, a carrier portion 10, a metal reinforcing member 14, a trim portion 20. Van Den Oord is silent concerning a light generating line.

However, German Patent Publication No. 198 41 180 discloses a side emitting optic glass fiber cable 9 for illuminating the area around a door.

Additionally, German Patent Publication No. 197 44 240 discloses placing a light generating lines 58 in the sealing portion of a sealing member 73 via a seating channel (not numbered, but seen in figure 8), the light generating lines do not extend the entire length of the seal as shown in figure 9.

It would have been obvious to one of ordinary skill in the art to provide Van Den Oord with a pair of side emitting optic glass fiber cables, as taught by German Patent

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Publication No. 198 41 180, in the sealing portion of Van Den Oord, as taught by German Patent Publication No. 197 44 240, to illuminate the area surrounding the door opening for safety.

Response to Arguments

Applicant's arguments filed August 28, 2003 have been fully considered but they moot in view of the new grounds of rejection.

With respect to the applicant's comments concerning German Patent Publication No. 197 44 240, the examiner respectfully disagrees. German Patent Publication No. 197 44 240 discloses a seal in figure 8 which is preferably used in a threshold. However, the seal disclosed in figure 8 can be used in any environment which would utilize a seal of this nature, i.e., a seal that seals between a door and a door frame. Moreover, German Patent Publication No. 197 44 240 discloses the same structure as recited in the claims. Therefore, it is unclear what limitations make the applicant's claimed invention a "vehicular weather seal" and the invention disclosed by German Patent Publication No. 197 44 240 not a vehicular weather seal. It should be noted that the applicant is not claiming the combination of a vehicle and a weather seal. As shown in figure 7 of German Patent Publication No. 197 44 240 the sealing portion, i.e., the portion of the strip 73 which receives the light source 58 is capable of engaging a properly dimensioned door. Since the applicant is using the "adapted to" language, German Patent Publication No. 197 44 240 only need disclose the ability to engage a door to anticipate the applicant's claimed invention.

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With respect to the applicant's arguments concerning the motivation to combine the references of record, the examiner respectfully disagrees. The rationale to modify or combine the prior art does not have be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Since the applicant has failed to address the reasoning/rationale supplied by the examiner as to why the modification would have been obvious, the applicant's arguments are not persuasive.

With respect to the applicant's comments that it is not obvious to combine the teachings of Van Den Oord and German Patent Publication No. 198 41 180, the examiner respectfully disagrees. German Patent Publication No. 198 41 180 discloses the use of a light disposed in a seal adjacent a door opening for illuminating the door opening. One with ordinary skill in the art armed with the teachings of German Patent Publication No. 198 41 180 would understand that the light/seal combination could be used for any opening that requires a seal and that provides ingress and egress for people. Moreover, it is well known to mount functional objects in vehicular seals. See U.S. Patent No. 5,163,731 and French Patent Publication No. 2 732 927 which both disclose a vehicular weather seal having a functional object inserted therein. Therefore, one with ordinary skill in the art would merely have to transfer the concept of placing an

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illumination device in a seal of a door opening from a door opening in a building to the door opening in a vehicle.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu". The signature is fluid and cursive, with a large initial "G" and a stylized "S".

Gregory J. Strimbu
Primary Examiner
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November 17, 2003